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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/691,493 | 10/24/2003 | Chun-Hung Kuo | MR3003-62 | 7226 |

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EXAMINER

CLARKE, SARA SACHIE

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3749

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------------------------------------------|--|
| Office Action Summary | Application No. 10/691,493 | Applicant(s) KUO ET AL. (1) | |
| | Examiner Sara Clarke | Art Unit 3749 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 24 (Fig. 1) and 40, 42, 44, 46, 48, 421, and 441 (Fig. 3).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 221, 223, 241, 243, 245, 26, 261, 263, and 265 (pages 4 and 7).

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "other gas burners" (claim 37) and the "other liquid burners" (claim 38) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet"

or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The specification does not provide antecedent basis for the following terms found in the claims: "coupling portion" (claim 21), "oil vapor lamp" (claims 33 and 34), "coupling body" (claim 35), lamp wick (claim 35), "lampshade (claim 35), "adjustment button" (claim 36), "other gas burners" (claim 37), and "other liquid burners" (claim 38). Correction is required.

Claim Objections

Claim 34 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 33. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31, 37, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

In claim 31, it is unclear what characteristics make a solvent a "common" solvent. The specification provides no guidance as to the meaning of this term.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 31 recites the broad recitation "common solvent," and the claim also recites "n-hexane" which is the narrower statement of the range/limitation.

In claims 37 and 38, the word "other" indicates that there is at least one gas or liquid burner besides the ones recited in these claims. However, claim 21, from which these claims depend provides for no such burners. Thus, it is unclear what the complement of "other" is for these claims. The specification provides no guidance as to the meaning of these claims. For claim 37, is the "oil vapor combustion device" of claim 21 considered to be a gas burner?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 24, 25, 30, 33, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (JP 56-59103).

Matsumoto et al. discloses the invention substantially as claimed with the exception of the vaporization tank 2 not being specifically a cylinder.

It has been held that a change in shape, absent persuasive evidence that the particular configuration was significant, was a matter of choice, which a person of ordinary skill in the art would have found obvious. See In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the present case, the tank 2 of Matsumoto et al. has a shape. To have modified it so that is a cylinder would have been obvious to one of ordinary skill in the art at the time of applicant's invention since applicant has provided no evidence that a cylindrical shape is significant.

Regarding claim 24, Fig. 1 of Matsumoto et al. shows an electric fan symbolically. As an electric fan, in order to operate, one of ordinary skill in the art would have recognized that it necessarily includes a motor.

Regarding claim 37, it has been held that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. See In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) In the instant case, Matsumoto et

al. provides only one burner 20. To have modified the apparatus of Matsumoto et al. so that it has at least two more than the one burner would have been obvious to one of ordinary skill in the art at the time of applicant's invention since applicant has provided no evidence that more than one burner provides any unexpected results.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (JP 56-59103) as applied to claim 24 above, and further in view of Kun-Ming (US 4106914).

Matsumoto et al. discloses the invention substantially as claimed with the exception of a pressure-controlling switch.

Kun-Ming discloses a vaporization tank and teaches the use of switch 31, which stopping the operation of the air compressor 2 if the pressure inside the tank increases. See column 3.

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the device of Matsumoto et al. with the switch taught by Kun-Ming for the purpose of stopping the fanning means if the pressure in the tank increases.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (JP 56-59103) as applied to claim 24 above, and further in view of Kunze (US 5370829).

Matsumoto et al. discloses the invention substantially as claimed with the exception of a battery for powering the fan motor.

Kunze discloses an induced-air vaporizing device and teaches the use of battery 18 for powering the motor.

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the device of Matsumoto et al. with a battery as taught by Kunze for the purpose of powering the fan motor.

Claims 21, 22, 24, 25, 27, 30, 33, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barbarin (US 82273) in view of Kun-Ming (US 4106914).

Barbarin discloses the invention substantially as claimed with the exception of a constant temperature means and fanning means.

Kun-Ming discloses a vaporization tank and teaches the use of a constant temperature means 5 for the purpose of facilitating vaporization of the liquid fuel. See column 3. Kun-Ming further teaches the use of fanning means 2 for the purpose of providing compressed air to the tank.

Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the vaporization tank of Barbarin with constant temperature means and fanning means as taught by Kun-Ming for the purpose of facilitating vaporization of the liquid fuel by providing heat and compressed air.

Regarding claim 37, it has been held that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. See In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) In the instant case, Barbarin provides one burner in Fig. 1 and a base for a second. To have modified the apparatus of Barbarin so that it has at least two more than the one burner would have been obvious to one of ordinary skill in the art at the time of applicant's invention since applicant has provided no evidence that more than one burner provides any unexpected results.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/691,494 in view of Lagreid et al. (US 3140740). This is a provisional obviousness-type double patenting rejection.

Claims 1-12 of application 10/691,494 recite all of the claim elements of claims 21-32 of the present application with the exception of a base and a coupling portion.

Lagreid et al. would have readily commended itself to the attention of one of ordinary skill in the art and is thus analogous prior art because it teaches the use of a gas appliance S used with a source of gas stored in a tank 10. Lagreid et al. teaches the use of a base 26 and a coupling portion 34 for the purpose of using the gas source with various gas appliances. See col. 1.

Thus it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the device of claims 1-12 of application 10/691,494 with

a coupling portion and base as taught by Lagreid et al. for the purpose of being able to use the gas source with various gas appliances.

Allowable Subject Matter

Claim 38 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chern (US 6189557), Guarnaschelli et al. (US 4193755), Sekiya et al. (JP 57-41509), Nishino et al. (JP 54-106935), and Tung-Chu (GB 1398953) disclose various vaporizing/combustion arrangements.

Contact Information

Any inquiry concerning this or earlier communications from the examiner should be directed to Sara Clarke whose phone number is 571-272-4873. The examiner normally can be reached Mon-Fri, 8:30-1:00.

If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Ira Lazarus, can be reached at 571-272-4877. The fax number for the organization where this application is assigned is 703-872-9306.

Status information for an application is available from the Patent Application Information Retrieval (PAIR) system. Status information for published applications is available from Private or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about PAIR, see <http://pair-direct.uspto.gov>. For questions on access to Private PAIR, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sara Clarke 
Primary Examiner
Art Unit 3749

March 21, 2005